IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: :
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Ana Belen Benitez et al.   :   Confirmation No.: 4490
                                               :
Serial No.: 09/495,175   :   Art Unit: 2142
                                               :
Filed: February 1, 2000   :   Examiner: B. Prieto
                                               :
For: Multimedia Integration Description   :
Scheme, Method and System for MPEG-7   :

<div align="center"><u>RESPONSE</u></div>

MAIL STOP: AF AMENDMENT
Commissioner for Patents
Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the final communication dated March 13, 2006, kindly consider

the following Amendments and Remarks.

Remarks begin on page 2 of this paper.

REMARKS

Reconsideration and allowance are requested. Claims 25-52 and 54-55 are

pending and no claims are amended.

Rejection of Claims 25 – 52 and claims 54 – 55 Under Section 101

The Examiner rejects claims 25-52 and 54 - 55 under Section 101 because the

claimed invention is directed to non-statutory subject matter. The Examiner states

that the method claims do "not seem to be described as being implemented in any

tangible and/or limited to any tangible embodiment(s) (e.g. hardware components)".

Applicants note that we previously amended the claims to recite a "computer-

implemented" method. Therefore, clearly there is a hardware component required.

Applicants have reviewed again the Interim Guidelines set forth in the 22 Nov. 2005

OG Notice. There does not appear to be anything in the guidelines that prevents an

appropriate method claim that is computer implemented from satisfying section 101.

As a computer-implemented method, these claims clearly fall in one of the four

enumerated categories of patentable subject matter of section 101.

On pages 7 and 8 of the Office Action the Examiner notes that "USPTO

personnel should no longer rely on the machine implemented test to determine

whether a claimed invention is directed to statutory subject matter." In this case,

however, this is exactly what the Examiner has done.   Applicants have complied and

rendered the method claims "computer-implemented." The Examiner notes on page 7

that the fact that a non-statutory method is carried out on a programmed computer

does not make the process claim statutory. Now, what Applicants submit is missing

from the Examiner's analysis is the required articulation of the prima *facie* case. As

stated in the OG Notice, it remains the Examiner's responsibility to establish a prima

face case of non-patentability. Applicants respectfully submit that the claims as they

stand comply with Section 101. The Examiner has made no attempt here to explain

why the computer-implemented method does not provide a useful, tangible or

concrete result or given any other analysis as to why these claims do not comply with

Section 101. The Benson case cited by the Examiner had a claim which converted a

binary-coded decimal number into pure binary numbers. That claim was not rejected

as non statutory because it was computer implemented but because if failed the *other*

tests for patentability – which the Examiner has not applied in the present case. Even

though Applicants are not obliged to rebut a case that has not been made, we submit

that the claims as they stand do recite statutory subject matter providing a tangible

result. Therefore, Applicants request the Examiner to withdraw this rejection or

present a prima facie case.

Rejection of Claims 25-5 and 54 - 55 Under Section 103(a)

Claims 25-52 and 54-55 are rejected under Section 103(a) as being

unpatentable over Bergman et al. (U.S. Pat. No. 6,564,263) ("Bergman et al."), in

view of International Organization of Standardization, Organization International

Normalization, ISO/IEC JTC1/SC29/WG11, Coding of Moving Picture and

Associated Audio, MPEG 98 (MPEG-7 Evaluation Process Document), Atlantic City,

October 1998, p. 1-75 ("ISO"). Applicants traverse this rejection.

Applicants submit that there is insufficient motivation or suggestion to

combine Bergman et al. with "ISO." The ISO document sets forth the Evaluation

Process for MPEG-7 and includes how those who desire to submit proposals should

be involved in the process. See Section 1.2. Apparently the document may be been

published in October 1998. (Applicants do not know or conceded that the document was legally published in Oct. 1998 inasmuch as MPEG often restricted the publication of documents associated with the standardization process.) Assuming that Oct. 1998 is the appropriate publication date, we note that the priority date for Bergman et al. is Dec. 4, 1998 and the present application was filed as a provisional Feb. 1, 1999. Bergman et al. cite that there exist "multiple standards and/or proposals relating to the exchange of various types of information" which "reinforces the recognition of the need to have a uniform content description framework." Col. 2, lines 53 – 57. MPEG-7 is actually referenced several times in Bergman et al. See Col. 22, lines 21 – 24 and Col. 23, lines 31 – 35. Bergman et al. introduce their InfoPyramid that has as a goal the ability to provide multiple modalities for describing multimedia content. For example, Bergman note that there remains a need for solving some outstanding problems, including: "the lack of a unified means for describing the multiple modalities/multiple fidelities nature of multimedia content, the lack of a unified means for describing both spatial and temporal characteristics among multiple objects; and the lack of means for describing both streams and aggregations of multimedia objects." Col. 2, lines 57 – 67. Since MPEG-7 is reference expressly in Bergman et al., we can assume that Bergman et al. includes MPEG-7 and the ISO document as one of the "latest efforts".

Turning to the ISO document, on page 71, it states that "This document is intended to provide a brief overview of UML concepts, provide sufficient graphical notation to allow UML to be used as the graphical notation for responses to the MPEG-7 call for proposals. It's [sic] use is to be restricted to providing a graphical notation for description schemes (DSs) and descriptors (Ds)." Accordingly, the ISO document expressly limits the proposals to be related to "graphical notations" rather

than expanding out to other modalities such as temporal characteristics. Perhaps this restriction is what caused Bergman et al. to be critical of the current standards proposals such as MPEG-7.

Applicants respectfully submit that when these express details in each reference are analyzed it becomes clear that Bergman et al. were aware of the MPEG-7 ISO document and criticized such proposals for lacking certain features that the Bergman et al. InfoPyramid addressed. By way of an obviousness analysis, Applicants respectfully submit that these two references cannot be combined where Bergman et al. clearly criticizes standards-based proposals (of which the ISO is one) and urges a broader means for dealing with the multiple modalities and fidelities of multimedia content. At the same time, the ISO document expressly restricts proposals to provide for graphical notations for description schemes. Given that the standard is only by a preponderance of the evidence, Applicants submit that the preponderance is clearly against combination in this case.

Accordingly, claims 25 – 52 and 54 – 55 are patentable over the references and in condition for allowance.

<div align="center">**CONCLUSION**</div>

In view of the above, Applicants submit that all claims are patentable over the prior art of record and respectfully request that the Examiner's rejections of these claims be withdrawn.

Respectfully submitted,

Date: May 13, 2006

By: /Thomas M. Isaacson/

Correspondence Address:
John Etchells
AT&T Corp.
Room 2A-207
One AT&T Way
Bedminster, NJ 07921

Thomas M. Isaacson
Attorney for Applicants
Reg. No. 44,166
Phone: 410-414-3056
Fax No.: 410-510-1433